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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/448,946	05/24/1995	ARJUN SINGH	P0175C2	1239

7590 06/23/2004

Genentech, Inc.  
1 DNA Way  
SOUTH SAN FRANCISCO, CA 94080-4990

EXAMINER
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PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/448,946

Applicant(s)

SINGH, ARJUN

Examiner

Scott D. Priebe

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 April 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

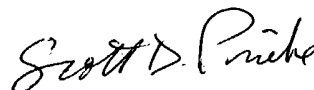
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 47-60.

Claim(s) withdrawn from consideration: 61-64.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



Scott D. Priebe  
Primary Examiner  
Art Unit: 1632

Continuation of 2. NOTE: The proposed amendment to page 1 does not comply with 37 CFR 1.121. Page, 1, lines 21-23 had been replaced by a preliminary amendment filed with the application on 5/24/95 (see transmittal sheet, item 7). The proposed amendment shows amendment of the text deleted from the specification by the preliminary amendment, not amendment of the text that replaced it. The remaining proposed amendments to the specification and claims would be entered if submitted in a separate, timely-filed amendment. However with respect to the remaining proposed amendments to the specification, should these proposed amendments be submitted again, Appellant is urged to refer to the amendment of 7/22/96 which added the text to be deleted to facilitate determining what is and is not present in the specification.

Continuation of 5. does NOT place the application in condition for allowance because: With respect to the rejection of claims 48-51, 53, 54, 56, 57, and 60 under 35 USC 112, 1st para., the claims recite that the coding sequence for the heterologous protein be connected to the coding sequence for the pre-pro peptide of yeast alpha factor, and that "the protein" be recovered from the media. A chimeric protein that comprises N-terminal amino acids derived from the C-terminus of the pre-pro peptide is not "the protein", as Appellant appears to be arguing. Consequently, the claim requires that the protein recovered be a properly processed "heterologous protein". With respect to the rejection over the Brake '008 or '026 patent, the claims do require that the chimeric pre-pro-protein be properly processed such that the heterologous protein be recovered from the culture for the preceding reason. Also, Appellant refers to documents and declarations from the Singh v. Brake interference as being attached to the reply. However, these documents were not attached, nor was a showing as required under 37 CFR 1.195. The only attachment was a declaration by Hitzeman. With respect to the rejection over Kurjan, Appellant's arguments rely solely on the Hitzeman declaration. However, this declaration has not been considered as indicated in item 6. The submission of the declaration does not comply with 37 CFR 1.195, see MPEP 1211.02. Consequently, the arguments are moot.